

#3

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From: Kawai Lau, Ph.D.

Date: August 22, 2001

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**Comments: PETITION TO WITHDRAW ABANDONMENT IN RESPONSE TO NOTICE OF ABANDONMENT DATED 7/20/01.**

Re: U.S. Patent Application: Serial No. 09/868,152 -  
PCT/US00/02972

Filed: I.A. FILING DATE: 2/4/00 - PRIORITY DATE: 2/5/99

For: ANTIZYME MODULATORS AND THEIR USE

By: VERMEULIN, et al.

Our reference: 27510-20012.40

PATENT  
Docket No. 275102001240

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on August 22, 2001.

  
RHEA AMID

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re International application of:

Oridigm Corporation

PCT Application No.: PCT/US00/02972

Int'l Filing Date: 04 February 2000

For: ANTIZYME MODULATORS AND  
THEIR USE

Examiner: To be assigned

Group Art Unit: To be assigned

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER  
37 C.F.R. § 1.181(a)

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In response to Notice of Abandonment dated July 20, 2001, Applicant petitions for the withdrawal of the holding of abandonment pursuant to 37 C.F.R. § 1.181(a) and MPEP 711.03(c)I and submits the following:

1. Copy of Notice of Abandonment dated July 20, 2001.
2. Copy of Decision on Petition to Accept U.S. as Designated Office dated August 2, 2001.
3. Copy of Notice of Receipt of Demand dated September 19, 2000.

Applicant submits that the instant PCT application was abandoned in error, as evidenced by attached documents which demonstrate that the U.S. is accepted as a designated state and that a proper Demand was timely filed and accepted by the European Patent Office.

Applicant respectfully requests that the holding of abandonment be withdrawn and the instant application be reinstated.

No fees are believed due at this time. The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this petition, or to credit any overpayment, to Deposit Account No. 03-1952 referencing 275102001240. *The Assistant Commissioner is not authorized to charge the issue fee.*

Dated: August 22, 2001

By: 

Kawai Lau  
Registration No. (44,461)

Morrison & Foerster LLP  
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H/C

**URGENT**

UNITED STATES DEPARTMENT OF COMMERCE  
 Patent and Trademark Office  
 Address: ASSISTANT COMMISSIONER FOR PATENTS  
 Box PCT  
 Washington, D.C. 20231

U.S. APPLICATION NO. 09/868152	FIRST NAMED APPLICANT VERMEULIN	ATTY. DOCKET NO. N 27510-200124.40
KAWAI LAU MORRISON & FOERSTER 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130 2332		INTERNATIONAL APPLICATION NO. PCT/US00/02972
		I.A. FILING DATE 04 FEB 00
		PRIORITY DATE 05 FEB 99
DATE MAILED: 20 JUL 2001		

**NOTIFICATION OF ABANDONMENT**

The United States Patent and Trademark Office in its capacity as

☒ a Designated Office (37 CFR 1.494) ☐ an Elected Office (37 CFR 1.495), has made the following determination:

- ☐ Applicant's letter of express abandonment received CFR 1.138 and is hereby acknowledged. is in compliance with
- ☒ Applicant has failed to provide the full U.S. Basic National Fee by ☒ 20 months (37 CFR 1.494(b)(2)), ☐ 30 months (37 CFR 1.495(b)(2)).
- ☐ Applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed within the time period set therein.
- ☐ Applicant has failed to properly respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed within the time period set therein. See the attached NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916). RECEIVED
- ☒ Other.  
THIS FILE WAS FILE UNDER CHAPTER ONE 20 MTH.  
SHOULD HAVE FILE 05 OCT , 00

JUL 20 2001

MORRISON & FOERSTER  
SAN DIEGO

Therefore, the above identified application failed to meet the requirements of 35 U.S.C 371 and 37 CFR ☐ 1.494, ☐ 1.495 and is ABANDONED AS TO THE UNITED STATES OF AMERICA.

Vonda M. Wallace V/W

Telephone: 703-305-3653

FORM PCT/DO/EO/909 (May 1993)

**URGENT**

DOCKETED Confirm Abandonment  
 REMINDER: 8/2/01  
 DUE DATE: 8/5/01  
 FINAL DUE DATE: 8/5/01



AUG 02 2001

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800, 801, 802, 803, 804, 805, 806, 807, 808, 809, 810, 811, 812, 813, 814, 815, 816, 817, 818, 819, 820, 821, 822, 823, 824, 825, 826, 827, 828, 829, 830, 831, 832, 833, 834, 835, 836, 837, 838, 839, 840, 841, 842, 843, 844, 845, 846, 847, 848, 849, 850, 851, 852, 853, 854, 855, 856, 857, 858, 859, 860, 861, 862, 863, 864, 865, 866, 867, 868, 869, 870, 871, 872, 873, 874, 875, 876, 877, 878, 879, 880, 881, 882, 883, 884, 885, 886, 887, 888, 889, 890, 891, 892, 893, 894, 895, 896, 897, 898, 899, 900, 901, 902, 903, 904, 905, 906, 907, 908, 909, 910, 911, 912, 913, 914, 915, 916, 917, 918, 919, 920, 921, 922, 923, 924, 925, 926, 927, 928, 929, 930, 931, 932, 933, 934, 935, 936, 937, 938, 939, 940, 941, 942, 943, 944, 945, 946, 947, 948, 949, 950, 951, 952, 953, 954, 955, 956, 957, 958, 959, 960, 961, 962, 963, 964, 965, 966, 967, 968, 969, 970, 971, 972, 973, 974, 975, 976, 977, 978, 979, 980, 981, 982, 983, 984, 985, 986, 987, 988, 989, 990, 991, 992, 993, 994, 995, 996, 997, 998, 999, 1000
Reviewed by [Signature]
Initials: [Signature]

In re Application of  
ORIDIGM CORPORATION  
Int. Application No.: PCT/US00/02972  
Int. Filing Date: 04 February 2000  
Priority Date: 05 February 1999  
Attorney Docket No.: 275102001240  
For: ANTIZYME MODULATORS AND THEIR USE

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. 1.182 or Alternative Under 37 C.F.R. 1.183 to Accept the United States of America as a Designated Country Under 35 U.S.C. 363" filed 12 June 2001.

#### BACKGROUND

On 04 February 2000, applicant filed with the United States Receiving Office (RO/US), *inter alia*, a Transmittal Letter, Request, and Fee Calculation Sheet. The submission was assigned the above-identified International Application Number and International Filing date.

On 12 June 2001, applicant filed the present petition requesting that the United States Receiving Office correct the designation of this international application to include the United States. The petition includes authorization to charge the requisite petition fee of \$130 to Deposit Account No. 03-1952.

#### DISCUSSION

A review of the application file reveals that in Box No. V of the Request, the box used to indicate the designation of the United States of America was not checked. However, Nicolas M.J. Vermeulin, Mark R. Burns, and Heather K. Webb are indicated as applicants/inventor for the United States of America only. These indications are clear indications that applicants designated the United States of America. Accordingly, on 04 February 2000 the United States of America was designated.

Applicants have requested that the RO/US correct the obvious error and to allow for the Request to be corrected by checking the box used to indicate the designation of the United States of America. The Office must look to all the papers deposited on 04 February 2000 to determine whether an obvious error as defined in FCT Rule 91.1(b) is present. Rule 91.1(b) states,

Errors which are due to the fact that something other than what was obviously intended was written in the international application or other

Application No.: PCT/US00/02972

-2-

paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended that what is offered as rectification.

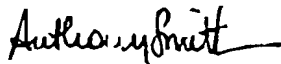
As discussed, since the United States of America was in fact designated in the Request, applicant's request to rectify Box No. V, Designation of States, by checking the box adjacent the United States of America is granted.

CONCLUSION

For the reasons above, the present petition under 37 CFR 1.182 is GRANTED.

The requisite \$130.00 petition fee will be charged to Deposit Account No.03-1952.

The application will be forwarded to the RO/US for further processing in accordance with this decision, including correcting Sheet No.3 of the Request to indicate the United States of America as a designated state.



Anthony Smith  
Petitions Attorney  
PCT Legal Office  
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PCT Legal Examiner  
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ORIGINAL

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## Facsimile Cover Sheet

To: <u>Melanie Carmosino</u>	From: <u>Carol B. Dwyer</u>
Fax: <u>858 720 5125</u>	Pages: <u>3</u>
Phone: <u>858 720 7979</u>	Date: <u>7 Aug 2001</u>
Re: <u>PCT/US00/02972</u>	cc:

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Here's a copy of the petition decision.

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## INTERNATIONAL COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

LAU, Kawai  
MORRISON & FOERSTER LLP  
2000 Pennsylvania Avenue, N.W.  
Washington, D.C. 20006-1888  
ETATS-UNIS D'AMERIQUE

NOTIFICATION OF RECEIPT  
OF DEMAND BY COMPETENT INTERNATIONAL  
PRELIMINARY EXAMINING AUTHORITY(PCT Rules 59.3(e) and 61.1(b), first sentence  
and Administrative Instructions, Section 601(a))Date of mailing  
(day/month/year)

19. 09. 00

Applicant's or agent's file reference

275102001240

## IMPORTANT NOTIFICATION

International application No.

PCT/US 00/ 02972

International filing date (day/month/year)

04/02/2000

Priority date (day/month/year)

05/02/1999

Applicant

ORIDIGM CORPORATION

1. The applicant is hereby notified that this International Preliminary Examining Authority considers the following date as the date of receipt of the demand for international preliminary examination of the international application:

31/08/2000

2. This date of receipt is:

- ☒ the actual date of receipt of the demand by this Authority (Rule 61.1(b)).  
☐ the actual date of receipt of the demand on behalf of this Authority (Rule 59.3(e)).  
☐ the date on which this Authority has, in response to the invitation to correct defects in the demand (Form PCT/IPEA/404), received the required corrections.

3. ☐ **ATTENTION:** That date of receipt is **AFTER** the expiration of 19 months from the priority date. Consequently, the election(s) made in the demand does (do) not have the effect of postponing the entry into the national phase until 30 months from the priority date (or later in some Offices) (Article 39(1)). Therefore, the acts for entry into the national phase must be performed within 20 months from the priority date (or later in some Offices) (Article 22). For details, see the *PCT Applicant's Guide*, Volume II.

- ☐ (If applicable) This notification confirms the information given by telephone, facsimile transmission or in person on:

4. Only where paragraph 3 applies, a copy of this notification has been sent to the International Bureau.

Name and mailing address of the IPEA/



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D-80298 Munich  
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Authorized officer

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